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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEN, QING

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2191

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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/712,828	Applicant(s) BIGUS, JOSEPH P.	
	Examiner Qing Chen	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15,17-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,17-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to the RCE filed on August 29, 2007.
2. **Claims 1, 2, 4-15, 17-27, and 29-31** are pending.
3. **Claim 26** has been amended.
4. **Claims 3, 16, and 28** have been cancelled.
5. The objection to the specification due to a typographical error is withdrawn in view of Applicant's amendments to the specification. However, Applicant's amendments to the specification fail to fully address the objection due to the use of trademarks. Accordingly, this objection is maintained and further explained below.
6. The 35 U.S.C. § 101 rejections of Claims 26, 27, and 29-31 are maintained in view of Applicant's arguments and amendments to the claims and further explained below.

Response to Amendment

Specification

7. The use of trademarks, such as JAVA, has been noted in this application (in particular, paragraphs [0049] and [0063]). Trademarks should be capitalized wherever they appear (capitalize each letter OR accompany each trademark with an appropriate designation symbol, *e.g.*, TM or ®) and be accompanied by the generic terminology (use trademarks as adjectives modifying a descriptive noun, *e.g.*, "the JAVA programming language").

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Objections

8. **Claims 26, 27, and 29-31** are objected to because of the following informalities:

- **Claim 26** contains a typographical error: "A computer-readable media" should read -- A computer-readable medium --.
- **Claims 27 and 29-31** contain a typographical error: "The computer-readable media" should read -- The computer-readable medium --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 26, 27, and 29-31** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26, 27, and 29-31 recite "computer-readable media" as a claimed element. However, it is noted that the originally-filed specification describes such computer-readable media as embracing transmission media. Transmission media can take the form of acoustic or light waves, such as those generated during radio frequency (RF) and infrared (IR) data communications (*see Paragraph [00102]*). In addition, the originally-filed specification also describes common forms of computer-readable media as to include carrier wave (*see Paragraph*

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[00102]). Furthermore, the originally-filed specification discloses that various forms of computer-readable media may be involved in carrying (emphasis added) one or more sequences of one or more instructions to CPU for execution (*see Paragraph [00103]*). Consequently, the computer-readable media can be reasonably interpreted as an electromagnetic carrier signal.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism *per se*, and as such are nonstatutory natural phenomena. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 112-14 (1853). Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1, 2, 4-15, 17-27, and 29-31** are rejected under 35 U.S.C. 102(e) as being anticipated by **Grindrod et al.** (US 6,868,413).

As per **Claim 1**, Grindrod et al. disclose:

- designating a customizable element of a set as a customizable template (*see Column 8: 27-37, "Preferably for each condition, two expressions 242, 244 and a comparison operator 246 for comparing values of the two expressions as well as a logical operator 248 for allowing grouping of conditions may be specified. The two expressions 240, 242 may be created by the administrator using an expression builder ..."*);
- compiling said customizable element into at least one object to form a ruleset (*see Column 14: 25-27, "... XML is generated from data regarding the new or modified business rule as entered or modified via the user interfaces."*; *Column 20: 50-53, "Examples of computer or program code include machine code, as produced, for example, by a compiler, or files containing higher level code that may be executed using an interpreter."*); and
- parsing said set to detect said customizable element designated as a customizable template (*see Figure 4: 232 and 234; Column 8: 44-57, "The business logic application preferably processes each condition line by line beginning with the first condition specified in the user interface 230." and "... the business logic application evaluates the first condition 232 to determine if the transaction data for state is equal to C. If the first condition 232 is met, then the business logic application proceeds to evaluate the second condition 234."*).

As per **Claim 2**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- wherein said set comprises a ruleset (*see Figure 2; Column 7: 8-16, "The business rules management console 200 facilitates management of the business rules application and*

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allows the administrator or end user to create and/or modify business rules in order to customize business processes. ").

As per **Claim 4**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- customizing said element (*see Column 11: 41-48, "The following are examples of expressions in which symbols are designated with braces characters {}. Examples of expressions include: Hello, the time is {TIME}. The Help Desk Ticket {TR, Problem No.} was created in response to your request on {DATE} at {TIME}. {DB, Clients, Client ID, "Sequence"=1221} ... ").*

As per **Claim 5**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- wherein said element comprises a variable (*see Column 11: 49-55, "... symbols may represent various types of data such as ... system environmental variables ... ").*

As per **Claim 6**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- wherein said element comprises a rule (*see Column 11: 49-55, "... symbols may represent various types of data such as ... business rules templates ... ").*

As per **Claim 7**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- wherein said element comprises a ruleset (*see Column 11: 49-55, "... symbols may represent various types of data such as ... business rules templates ... "*).

As per **Claim 8**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- designating a ruleset of said set as a customizable ruleset template (*see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules."*).

As per **Claim 9**, the rejection of **Claim 8** is incorporated; and Grindrod et al. further disclose:

- generating a customized ruleset from the customizable ruleset template (*see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules." and 48-49, "Templates allow the same string of text to be re-used by multiple business rules."*).

As per **Claim 10**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

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- enabling customization in a deployment environment (*see Column 7: 39-44, "In particular, FIGS. 3-6 are exemplary user interfaces 220, 230, 250, and 270 for entering or modifying and displaying general information, conditions, actions, and schedule, respectively, regarding a new business rule or an existing business rule selected via, for example, the business rules manager."*).

As per **Claim 11**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- enabling customization in a development environment (*see Column 7: 39-44, "In particular, FIGS. 3-6 are exemplary user interfaces 220, 230, 250, and 270 for entering or modifying and displaying general information, conditions, actions, and schedule, respectively, regarding a new business rule or an existing business rule selected via, for example, the business rules manager."*).

As per **Claim 12**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- re-editing a previously generated rule (*see Column 7: 30-32, "From the business rules management console 200, the administrator may elect to create, modify, or delete a business logic rule."*).

As per **Claim 13**, the rejection of **Claim 1** is incorporated; and Grindrod et al. further disclose:

- wherein a new ruleset is generated from a customizable ruleset template, and a pre-existing customizable rule template is associated with said new ruleset and is unchanged (*see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules."* and 48-49, *"Templates allow the same string of text to be re-used by multiple business rules."*).

Claims 14, 15, and 17-25 are system claims corresponding to the method claims above (Claims 1, 2, 4-12) and, therefore, are rejected for the same reasons set forth in the rejections of Claims 1, 2, 4-12.

As per **Claim 26**, Grindrod et al. disclose:

- designating a customizable element of a set as a customizable template (*see Column 8: 27-37, "Preferably for each condition, two expressions 242, 244 and a comparison operator 246 for comparing values of the two expressions as well as a logical operator 248 for allowing grouping of conditions may be specified. The two expressions 240, 242 may be created by the administrator using an expression builder ..."*);
- compiling said customizable element into at least one object to form a ruleset (*see Column 14: 25-27, "... XML is generated from data regarding the new or modified business rule as entered or modified via the user interfaces."*; *Column 20: 50-53, "Examples of computer or program code include machine code, as produced, for example, by a compiler, or files containing higher level code that may be executed using an interpreter."*);

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- storing said ruleset (*see Column 15: 2 and 3, "... the verified new or modified business rule is committed to the database."*); and
- parsing said set to detect said customizable element designated as a customizable template (*see Figure 4: 232 and 234; Column 8: 44-57, "The business logic application preferably processes each condition line by line beginning with the first condition specified in the user interface 230." and "... the business logic application evaluates the first condition 232 to determine if the transaction data for state is equal to C. If the first condition 232 is met, then the business logic application proceeds to evaluate the second condition 234."*).

As per **Claim 27**, the rejection of **Claim 26** is incorporated; and Grindrod et al. further disclose:

- wherein said set comprises a ruleset (*see Figure 2; Column 7: 8-16, "The business rules management console 200 facilitates management of the business rules application and allows the administrator or end user to create and/or modify business rules in order to customize business processes."*).

As per **Claim 29**, the rejection of **Claim 26** is incorporated; and Grindrod et al. further disclose:

- customizing said element (*see Column 11: 41-48, "The following are examples of expressions in which symbols are designated with braces characters {}. Examples of expressions include: Hello, the time is {TIME}. The Help Desk Ticket {TR, Problem No.} was created in*

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*response to your request on {DATE} at {TIME}. {DB, Clients, Client ID, "Sequence"=1221}
...").*

As per **Claim 30**, the rejection of **Claim 26** is incorporated; and Grindrod et al. further disclose:

- designating a ruleset of said set as a customizable ruleset template (*see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules."*).

As per **Claim 31**, the rejection of **Claim 30** is incorporated; and Grindrod et al. further disclose:

- generating a customized ruleset from the customizable ruleset template (*see Column 12: 41-44, "Preferably, business rules templates are provided. Business rules templates are predefined and reusable text items that can be defined, stored, and reused by various business rules." and 48-49, "Templates allow the same string of text to be re-used by multiple business rules."*).

Response to Arguments

13. Applicant's arguments filed on August 29, 2007 have been fully considered, but they are not persuasive.

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In the remarks, Applicant argues that:

a) Claims 26-27 and 29-31 recite computer-readable media for storing software instructions for customizing a rule-based application. As the Supreme Court has recognized, Congress chose the expansive language of 35 USC §101 so as to include "anything under the sun that is made by man" as statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980) (MPEP 2106, emphasis added). The Applicants respectfully submit that computer-readable media, including acoustic or light waves carrying instructions that are readable by a processor, are made by man and are not naturally occurring phenomena.

The Examiner nevertheless submits that "the phrase 'anything under the sun that is made by man' is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process" (emphasis added). The Applicants submit that a computer-readable medium, including acoustic or light waves carrying instructions that are readable by a processor, qualifies as a "manufacture" under the provisions of 35 U.S.C. §101, which allows for a broad interpretation of the term "manufacture" (See, e.g., MPEP 2105). For instance, the Court in *Chakrabarty* found that "in choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope". The Court further found that a "nonnaturally occurring manufacture or composition of matter - a product of human ingenuity - having a distinctive name, character, [and] use" is patentable subject matter (emphasis added). As discussed above, computer readable media - even including acoustic or light waves - that carries instructions readable by a processor is not a naturally occurring

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phenomena, but rather owes existence to human ingenuity and intervention that bestows "new forms, qualities, properties, or combinations".

Examiner's response:

a) Examiner disagrees with Applicant's assertion that computer-readable media, including acoustic or light waves carrying instructions that are readable by a processor, are made by man and are not naturally occurring phenomena. As previously pointed out in the Final Rejection (mailed on 05/31/2007) and currently maintained by the Examiner, the 35 U.S.C. § 101 rejections of Claims 26, 27, and 29-31 are consistent with the Office's current policies regarding non-statutory subject matter. Such signal claims are ineligible for patent protection because they do not fall within any of the four statutory categories of § 101 (process, machine, manufacture, or composition of matter). The recited processor of the claims only serves as an intended use limitation rather than a hardware component to qualify it as a product of manufacture.

In the remarks, Applicant argues that:

b) By contrast, the cited portions of Grindrod at most teach that a user (e.g., an administrator) can build expressions or conditions for business logic rules by entering variables into a user interface that has been dictated to the user. In other words, Grindrod teaches a method for completing a predefined "template" having predefined fields that are modifiable by a user (i.e., the user interface tells the user what is "customizable"). Nowhere in Grindrod is a method taught in which the user interface - or a template - itself is created by designating which elements of a set will be customizable by a user (e.g., such that the user can decide what is customizable).

Examiner's response:

b) In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (*i.e.*, a user can decide what is customizable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Qing Chen whose telephone number is 571-270-1071. The Examiner can normally be reached on Monday through Thursday from 7:30 AM to 4:00 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wei Zhen, can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.(toll-free).

QC / *QC*
October 3, 2007

A handwritten signature in black ink, consisting of stylized, cursive letters that appear to read 'WZ' followed by a long, sweeping horizontal stroke.

WEI ZHEN
SUPERVISORY PATENT EXAMINER